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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/954,789 | 09/12/2001 | Charlie Ricci | 018413-378 | 8809 |

7590 02/14/2003

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EXAMINER

SHARAREH, SHAHNAM J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1617

DATE MAILED: 02/14/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/954,789

Applicant(s)

RICCI ET AL.

Examiner

Shahnam Sharareh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16 and 20-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16 and 20-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Request for Reconsideration of filed on Jan 22, 2003 has been entered. The Declaration under 37 CFR 1.132 filed Jan 22, 2003 is sufficient to overcome the rejection of claims 16, 20-29 based upon the evidence showing that vascular stent graft in the art are viewed to be different from vascular stent or vascular graft. Accordingly, the finality of that last Office Action is withdrawn.

Claims 16, 20-29 are now pending.

New Grounds of Rejection

Claims 16, 20-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCrory US Patent 5,951,599 in view of Chuter et al (J Vasc Surg 2000; 31:122-33), May J Vasc Surg 2000; 32:124-129) and Evans et al US Patent 5,695,480.

McCrory teaches occlusive systems including a stent for deployment in the parent vessel and a polymeric embolizing composition to seal aneurysm sac (see abstract, col 5, lines 25-58; col 6, lines 15-60; col 12, lines 13-25). McCrory does not teach stent grafts.

Chuter and May collectively teach that stent grafts and stents are interchangeably used in the art to treat vascular aneurysm. Specifically, Chuter describes endovascular repair methodologies in patients using stent grafts (abstract; pages 126-130). May describes that both first generation prostheses, such as stents, and second generation prostheses, such as stent grafts, are effective in treating abdominal aortic aneurysm (see abstract, table III at page 127; pages 127-129).

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Evans is merely used to show that assembling a kit for vascular repair procedure comprising an embolic polymeric composition that can solidify in vivo, and a prosthetic device such as a metal coil with different size catheters for delivering the composition and arresting the blood flow during the procedure (see abstract, col 4, lines 26-47; col 10, lines 31-41; col 11, lines 52-67; col 13, lines 1-43). Evens fails to teach the stent graft in his kits.

However, absence of showing unexpected results, it is *prima facie* obvious to combine two compositions each of which is taught by prior art to be useful for same purpose in order to form third composition that is to be used for very same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus, claims that require no more than mixing together of conventional elements used in the art for the same purpose set forth *prima facie* obvious subject matter. *In re Kerkhoven*, 205 USPQ 1069(CCPA) 1980. In the instant case, all elements of the instant claims are taught in the art. Accordingly, it would have been obvious at the time of invention to add a stent grafts taught by Chutter and May to McCrory's system and assemble a kit to facilitate convenience during a vascular repair procedure as taught by Evens.

Moreover, as shown by Chutter and May Stent grafts and Stents are art recognized equivalent in the art of treating vascular repair. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to substitute the Stent of McCrory's system with a Stent graft taught in May and form a surgical kit as

shown by Evans, because the ordinary skill in the art would have had a reasonable expectation of success in achieving similar therapeutic results as McCrory.

Conclusion

No claims are allowed.

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on Jan 22, 2003 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 703-306-5400. The examiner can normally be reached on 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, PhD can be reached on 703-308-1877. The

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fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

2/10/03

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RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200